

REMARKS

1. Applicant thanks the Office for its remarks and suggestions which have greatly assisted Applicant in responding.

2. INFORMATION DISCLOSURE STATEMENT

Applicant notes the Office's objection to the IDS of March 4, 2008. Responsive thereto, Applicant provides an additional IDS that lists the references with the dates that were inadvertently omitted from the earlier-filed IDS. The present objection is therefore overcome.

3. 35 U.S.C. § 103

Claims 1, 6 and 16 are rejected as being unpatentable over U.S. Patent No. 6,502,194 ("Berman") in view of U.S. published application no. 2001/0030660 ("Zainoulline") and further in view of U.S. published application no. 2002/0059237 ("Kumagai"). Applicant respectfully disagrees.

There is no teaching or suggestion in the combination of deleting all pre-cached songs preceding a target song that the user skips to at the same time that the target song starts to play. At col. 12, lines 49-52, Berman describes "If a user decided not to listen to the current song and skips it entirely on playback, it remains in the playback unit memory so the user can return to the skipped song and listen to it." Thus, even though songs preceding a target song may eventually be overwritten, as described at col. 12, lines 25-30, because songs are retained in the playback memory so that the user can return to the skipped song, there is no teaching or suggestion in Berman that all songs preceding the target song are deleted at the same time that the target song starts to play.

The Office relies on Berman: col.12, lines 55-57, 55-63 and various teachings regarding buffer size from col. 11. However, the aggregation of these

teachings is insufficient to show that the combination teaches the claim element in question without the highly speculative, completely unsupported contention by the Office that it would be obvious to alter buffer size, and that if the buffer size had been adjusted in such a way that Berman's device had only two buffers, then the Claim element would be taught or suggested by the combination. The problem with this rationale is that the combination does not teach or suggest that the buffer size be adjusted. Berman teaches only that the buffers are approximately 2MB in size. The Office points to no other teaching from the combination that buffer size be adjusted in such as way that the device would end up having only two buffers.

Applicant is uncertain under what authority the Office offers the contention. Is it a finding based on Official Notice? Is it a finding that it is commonly known in the art to adjust buffer size in order to compensate for changes in play length, connection speed and the like? Without proper documentary support for its contention, relying on the contention to demonstrate *prima facie* obviousness is improper. Applicant respectfully requests that the Office provide documentary support for its contention that it would be obvious to adjust buffer size in such a way that the device described by the combination would have only two buffers. Barring such a showing, the present rejection is fatally flawed, and therefore ineffective to demonstrate that Claim 1 is unpatentable over the combination.

The rejection of Claims 6, 16 and 31 is improper for the same reasons that the rejection of Claim 1 is improper.

In view of the foregoing, Claims 1, 6, 16 and 31 are deemed allowable over the combination.

In view of their dependence from allowable parent claims, the dependent claims are deemed allowable without any separate consideration of their merits.

4. **DOUBLE PATENTING**

Claim 1-24, 31 and 32 are rejected under the judicially-created doctrine of obviousness-type double-patenting as being unpatentable over Claims 1-25 of co-pending Application ser. no. 10/538,334 in view of Kumagai.

The Office alleges that Claims 1-25, 3[1] and 32 of the subject Application are anticipated by Claims 1-25 of the '334 Application. Applicant respectfully disagrees.

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1989). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimus verbis* test, i.e. identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990.) MPEP § 2131.

Thus, in order for a reference to anticipate a claim, the reference must teach each and every element of the claim, arranged as required by the Claim. Here, the Office readily admits that the co-pending application does not teach each and every element of the subject Claims, looking to Kumagi to supply the missing subject matter.

The Office is respectfully reminded that the fundamental issue in an obviousness-type double-patenting rejection is whether or not the claims of the subject application were obvious in view of the claims of the co-pending Application, not whether they were anticipated by the claims of the co-pending Application. Accordingly, due to the informal nature of the present rejection, it is deemed to be improper.

Nonetheless, Applicant provides herewith a terminal disclaimer for the '334 Application. The present rejection would therefore be overcome by same, even if it had not been improper on formal grounds.

5. No new matter is added by way of the above amendments. The above amendments are made only for the sake of expediency, in recognition of the Office policy of compact prosecution. They do not signify agreement by Applicant with the Examiner's position. Nor do they reflect intention to sacrifice claim scope. Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in one or more future submissions to the Office.

6. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

In view of the foregoing, the claims are deemed to be in allowable condition. Applicant therefore earnestly requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, he is urged to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,



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